



## UNITED STATES DEPARTMENT OF COMMERCE

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J.A.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/198,022 11/23/98 RHOADS

G 4830-51475/W

LM31/0709  
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EXAMINER

TADAYON, B

ART UNIT

PAPER NUMBER

3

2721

DATE MAILED:

07/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.	09/198,022	Applicant(s)	R Hoffs
Examiner	B. TADAYON	Group Art Unit	2721 PAPER #3

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on APPLIC. FILED 1-23-98.  
 This action is FINAL.  
 Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-7 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) 1-7 is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

(ALL FIGURES: APPROVED BY DRAFTSPERSON.)

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- |  |   |
|--|---|
| <input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ | <input type="checkbox"/> Interview Summary, PTO-413                     |
| <input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892                  | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948           | <input type="checkbox"/> Other _____                                    |

## Office Action Summary

**Office Action**

1. Claim 3 is objected to because there are two periods at the end of this claim. One of them should be omitted.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, all pending claims, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5841886 (SN 08/763847, the parent case of the current application), and U.S. Patent No. 5850481 (SN 08/438159, the parent case of the current application). Although the conflicting claims are not identical, they are not patentably distinct from each other.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nathans (PN 4972476; supplied by applicant; see previous office actions of the parent case).

Also, please see the reasons given in the previous office actions for parent cases, for example, see PN 5841886, SN 08/763847, one of the parent cases.

As to claims 1, Nathans teaches these features (figure 2; figure 2; column 1 lines 40-45; figure 2; figures 2-4, column 3 lines 15-25; abstract).

As to claims 2-3, Nathans teaches these features (figure 2).

As to claims 4, Nathans teaches these features (figure 2, column 1 lines 29-40, column 1 lines 53-68, column 1 lines 5-19, column 2 lines 1-25, column 7 lines 27-41, column 7 lines 55-65).

As to claims 5, Nathans teaches these features (column 4 lines 25-55, column 5 lines 57-68, column 7 lines 54-68).

As to claims 6, Nathans teaches these features (column 3 lines 15-25).

6. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the double patenting rejection above should also be overcome first.

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Art Unit: 2721

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Bijan Tadayon whose telephone number is (703) 308-7595. The fax number is (703) 308-5397.

Dr. Bijan Tadayon

D. B. Tadayon

July 6, 1999

DR. BIJAN TADAYON  
PATENT EXAMINER  
GRACIP 2500